

Remarks

Applicant notes that amendment filed on September 22, 2002 in response to the Office Action of August 11, 2003 was considered non-compliant as it failed to provide a proper status identifier for each of the claims. This oversight now has been corrected and the response is being resubmitted.

The subject application has been carefully considered in view of the Office Action of August 11, 2003. Accordingly, a new independent Claim 15 is added that further defines the disposition of the fold lines and panels. The reference in Claim 15 to the fold lines being "sequentially arranged and substantially parallel one to another" is fully supported by at least the figures. Claims 1-9 are being resubmitted for the Examiner's further consideration as Applicant believes they patentably distinguish from the cited and applied prior art.

note.
As previously noted, the present invention is a combination picture frame and mailer. In particular, the mailer portion comprises a mailer front panel 32 and a mailer rear panel 28. To function as mailer panels it is inherent that the panels be of a size that cover the thing mailed. Thus, these mailer panels are arranged to completely enclose or cover both the face and the rear of the frame. By completely enclosing the frame portion the easel cutouts on the frame rear panel are protected during mailing. In addition, the line of perforations 30 that allows the mailer panel to tear away from the frame panels also is covered. Accordingly, neither the easel cutouts nor the separation line is exposed during the time the combination picture frame and mailer is in the postal system. In addition, the specification indicates that both mailer panels may contain writing areas.

Claim 1 is directed to a four panel structure wherein the mailer rear panel is foldably connected to the frame rear panel and the mailer front panel is foldably connected to the mailer rear panel. Such a four panel structure is neither disclosed nor rendered obvious by Wenkman.

The Examiner acknowledges that Wenkman does not disclose an arrangement including a mailer front panel and mailer rear panel connected along a fold line. To address the missing element the Examiner indicates it would be obvious to add another mailer panel in order to provide "more room for the user to write" and that adding such

an additional panel represents only a “mere duplication of the essential working parts of a device”.

In Applicant’s view, the Examiner has misconstrued the invention. Applicant has provided a second mailer panel, which is essential to the invention. As a secondary benefit, the specification indicates that structure of both mailer panels is such that one of the sides of both panels can be used as a writing area (the second mailer panel thus providing additional writing area). Thus, in the present invention, the secondary benefit is incidental and derives from the structure of the second panel that allows the second panel to function as a mailer panel.

In the Examiner’s analysis, the mere provision of another panel to provide more writing area renders the provision of a second mailing panel obvious. This is not the case. The mere provision of an extra writing panel does not necessarily provide the structure inherent in the use of that extra panel as a second mailer panel. There is nothing in the reference itself that suggest the possibility of a second mailer panel and the addition of a extra panel to the Wenkman structure merely to provide more writing room does not inherently provide a second mailer panel.

One is not equivalent to the other. In other words, in a four panel structure as set out in Claim 1, a second mailer panel can provide more writing area, but in the reference, adding another panel to provide more writing area does not necessarily provide a second mailing panel. Accordingly, Claim 1 is considered patentable over the reference.

Dependent Claim 5 specifies that the panel structure and fold lines allow the disposition of “the panels in an over laying configuration having an order of the mailer front panel, the frame rear panel, the frame front panel and the mailer rear panel”. Even if it were obvious to add a second “mailer” panel to the Wenkman structure (which it is not) there is no suggestion for providing the structural arrangement as claimed such that there is the claimed over laying configuration.

Independent Claim 7 is directed to the blank for making the combination picture frame and mailer. This claim recites that the mailer front and rear panels are “symmetrical about the third fold line”. Even if it were obvious to add a second mailer panel to the Wenkman structure, nothing in Wenkman suggests or makes obvious having

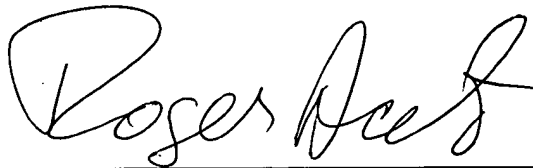
the mailer panels "symmetrical about the third fold line". Accordingly, Claim 7 is considered to be allowable over Wenkman.

Claims 2-4, 6 and 8-9 are not specifically discussed herein. However, as these claims include all the limitations of the respective independent Claims 1 and 7, they also are considered allowable.

New Claim 15 is similar to Claim 1 except it is more specific as to the disposition of the fold lines (they "being sequentially arranged and substantially parallel one to another"). The Claim also is specific as to the size of the panels in that they are "of a size permitting the disposition of the panels in an overlaying configuration one against another". Nothing in the three-panel structure of Wenkman suggests or makes obvious the arrangement as set out in Claim 15.

New dependent Claim 16 recites an arrangement wherein the "frame rear panel and therefore both the easel forming cuts and the separation line being disposed between the frame front panel and the mailer front panel". As set out above, it is the addition of the second mailer panel that provides protection for the easel forming cuts (and for the separation line) while the combination picture frame and mailer is in the postal system. Accordingly, in view of the comments as set out above, Claims 1-9, 15 and 16 are in condition for allowance, which action is respectfully requested.

Respectfully submitted,



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